

REMARKS

Claims 1-18 are pending in the Application. The Specification was objected to because references were cited without providing the corresponding serial numbers. Paper No. 4, page 2. Claims 1, 5, 6, 7, 11, 13 and 17 were objected. Paper No. 4, page 2. Claims 13-18 were rejected under 35 U.S.C. §§101 and 112. Paper No. 4, page 3. Claims 1-3, 5-9, 11-15 and 17-18 are rejected under 35 U.S.C. § 102(b). Paper No. 4, page 4. Claims 4, 10 and 16 are rejected under 35 U.S.C. § 103(a). Paper No. 4, page 9. Claims 19-22 have been added, and therefore, claims 1-22 are pending. Applicants respectfully traverse the rejections under 35 U.S.C. §§ 102 and 103 for at least the reasons provided below and respectfully request the Examiner to reconsider and withdraw the rejections to these claims.

Applicants note that claims 1, 5, 7, 11, 13 and 17 were not amended to overcome prior art but to correct typographical errors. Further, claims 13-18 were not amended to overcome prior art but to be clearly directed to statutory subject matter. Hence, the amendments made to claims 1, 5, 7, 11 and 13-18 were not narrowing in scope and therefore no prosecution history estoppel arises from the amendments to claims 1, 5, 7, 11 and 13-18. *Festo Corp v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-1712 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 1, 5, 7, 11 and 13-18 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

I. OBJECTIONS TO SPECIFICATION:

The Examiner has objected to the specification because references were cited without providing the corresponding serial numbers. Paper No. 4, page 2. Applicants accordingly have amended the specification to provide the corresponding serial numbers.

## II. OBJECTIONS TO THE CLAIMS:

The Examiner has objected to the claims 1, 7 and 13 because "a server" is recited as "a a server." Paper No. 4, page 2. The Examiner has further objected to claims 5, 11 and 17 because "transmitting said device" is recited as "transmitting said said device." Paper No. 4, page 2. Further, the Examiner has objected to claim 6 because "as claimed in claim 5" is recited as "as claimed in claim 6." Paper No. 4, page 2. Applicants have amended claims 1, 5, 6, 7, 11, 13 and 17 to correct the above-cited informalities.

## III. REJECTIONS UNDER 35 U.S.C. §101:

The Examiner has rejected claims 13-18 under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Paper No. 4, page 3. Applicants have amended claims 13-18 to be directed to statutory subject matter, and therefore claims 13-18 are allowable.

## IV. REJECTIONS UNDER 35 U.S.C. §112:

The Examiner has rejected claims 13-18 under 35 U.S.C. §112 because there is insufficient antecedent basis for the limitation of "said method comprising" in claims 13 and 17. Paper No. 4, page 3. Applicants have amended claims 13 and 17 to correct the insufficient antecedent basis, and therefore claims 13-18 are allowable.

## V. REJECTIONS UNDER 35 U.S.C. § 102(b):

The Examiner has rejected claims 1-3, 5-9, 11-15 and 17-18 under 35 U.S.C. § 102(b) as being anticipated by Debry (U.S. Patent No. 6,314,521). Applicants respectfully traverse these rejections for at least the reasons provided below and respectfully request the Examiner to reconsider and withdraw these rejections.

For a claim to be anticipated under 35 U.S.C. § 102, each and every claim limitation must be found within the cited prior art reference and arranged as required by the claim. M.P.E.P. § 2131.

Applicants respectfully assert that Debry does not disclose "a method for initializing a first device distributed with an embedded radio module using a server, said server having an embedded radio module" as recited in claim 1 and similarly in claims 7, 11, 13 and 17. The Examiner cites column 6, lines 4-7 and lines 16-17 and column 7, lines 20-24 of Debry as disclosing the above-cited claim limitation. Paper No. 4, page 4. Applicants respectfully traverse and assert that Debry instead discloses a printer sending a two part message to a server. The first part of the message contains the printer model and serial number, the printer's network address, and a request for a digital certificate. This first part of the message is encrypted with an encryption key built into the printer. The second part of the message contains the data, the same data as the first part, but the second part of the message is sent in the clear. Debry further discloses that the server decrypts the message by using the printer's unique key in its database and compares the decrypted message with the clear message. If both parts of the message match, then the server knows that the printer is authentic. Further, Debry discloses that the server builds a digital certificate for the printer, registering itself as a certificate authority. The server may then encrypt the contents of the digital certificate with the certificate authority's private key and send it to the printer. The database of the certificate authority server stores a new public key just sent to the device. The public key is then advertised for this printer. The database of the certificate authority server stores the new public key just sent to the device. The public key is then advertised for this printer and is used in all subsequent secure transactions with this printer. The printer decrypts the digital certificate using the certificate authority's public key and stores it in non-volatile memory in the printing system.

However, this language fails to disclose that the printer or server comprises an embedded radio module. Thus, Debry does not disclose all of the limitations of claims 1, 7, 11, 13 and 17, and thus Debry does not anticipate claim 1, 7, 11, 13 and 17. M.P.E.P. 2131.

Applicants further assert that Debry does not disclose "sending an inquiry from said server to said first device using said embedded radio modules" as recited in claim 1 and similarly in claims 7, 11, 13 and 17. The Examiner cites column 6, lines 33-34 of Debry as disclosing the above-cited claim limitation. Paper No. 4, page 4. This language in Debry discloses a printer establishing a session with a secure database server. However, this language does not disclose the printer using an embedded radio module for establishing a session with the secure database server. Thus, Debry does not disclose all of the limitations of claims 1, 7, 11, 13 and 17, and thus Debry does not anticipate claims 1, 7, 11, 13 and 17. M.P.E.P. § 2131.

Applicants also respectfully assert that Debry does not disclose "storing said private key in non-removable protected storage at said first device" as recited in claim 1 and similarly in claims 7, 11, 13 and 17. The Examiner cites column 6, lines 28-32 and 66-67 of Debry as disclosing above-cited claim limitation. Paper No. 4, page 4. This language in Debry discloses the printer decrypting the digital circuit using the certificate of authority's public key and storing the public key in a nonvolatile memory in the printing system. However, Debry does not disclose storing a private key in a non-removable protected storage. Further, a nonvolatile memory does not correspond to a non-removable protected storage. Thus, Debry does not disclose all of the limitations of claims 1, 7, 11, 13 and 17, and thus Debry does not anticipate claims 1, 7, 11, 13 and 17. M.P.E.P. § 2131.

Applicants further assert that Debry does not disclose "creating, at said first device, a public key, private key pair for said first device" as recited in claim 5. The Examiner cites column 6, lines 19-27 and 40-41 and column 8, lines 17-25 of Debry as disclosing the above-cited claim limitation. Paper No. 4, page 6. However, this

language discloses that when a printer is manufactured, a unique data encryption key is built into the printer. Debry only discloses a unique data encryption key but does not disclose a public key, private key pair. Thus, Debry does not disclose all of the limitations of claim 5, and thus Debry does not anticipate claim 5. M.P.E.P. § 2131.

Applicants further assert that Debry does not disclose "returning, from said first device, a unique device identifier and said public key of said first device, to said server" as recited in claim 5. The Examiner cites column 6, lines 36-43 of Debry as disclosing the above-cited claim limitation. Paper No. 4, page 6. However, this language discloses that the printer sends a message containing the printer model and serial number, the printer's network address and a request for a digital certificate. This message does not contain a public key of the first device. Thus, Debry does not disclose all the limitations of claim 5, and thus Debry does not anticipate claim 5. M.P.E.P. § 2131.

Applicants further assert that Debry does not disclose "creating, at said server, device certificate for said first device, said device certificate having said device identifier and said public key" as recited in claim 5. The Examiner cites column 6, lines 12-18 and column 9, lines 15-23 of Debry as disclosing the above-cited claim limitation. Paper No. 4, page 6. This language in Debry discloses the certificate authority generating a unique public/private encryption key pair for the printer and builds a digital certificate having the fields that includes a distinguished name of the printer, the issuer's distinguished name, the public key, the issuer's digital signature, the validity period and a serial number. While the device certificate includes a serial number that presumably was sent from the printer, the device certificate does not include a public key that was sent from the printer as the printer never transmitted a public key to the certificate authority. Thus, Debry does not disclose all of the limitations of claim 5, and thus Debry does not anticipate claim 5. M.P.E.P. § 2131.

Applicants further assert that Debry does not disclose "transmitting said device certificate and a public key of a Certificate Authority which signed said device

certificate to said first device" as recited in claim 5. The Examiner recites column 6, lines 52-64 and lines 10-11 and column 8, lines 26-28 and 38-44 of Debry as disclosing the above-cited claim limitation. Paper No. 4, page 6. This language in Debry discloses that the certificate authority sends a new private key along with a digital certificate to the printer. Hence, the certificate authority does not send a public key but a private key to the printer. Thus, Debry does not disclose all of the limitations of claim 5, and thus Debry does not anticipate claim 5. M.P.E.P. § 2131.

Claims 2-3, 6, 8-9, 12, 14-15 and 18-22 each recite combinations of features including the above combinations, and thus are not anticipated for at least the above stated reasons. Claims 2-3, 6, 8-9, 12, 14-15 and 18-22 recite additional features, which, in combination with the features of the claims upon which they depend are not anticipated by Debry.

For example, Debry does not disclose "wherein said protective storage is write-only storage able to perform computations involving previously-written data" as recited in claim 2 and similarly in claims 6, 8, 12, 14 and 18. The Examiner cites column 6, lines 66-67 of Debry as disclosing the above-cited claim limitation. Paper No. 4, page 8. However, this language discloses the printer storing the certificate authority's public key in a nonvolatile memory. A nonvolatile memory refers to memory specifically designed to hold information even when the power is switched off. This is not the same as being able to perform computations involving previously-written data. Thus, Debry does not disclose all the limitations of claims 2, 6, 8, 12, 14 and 18, and thus Debry does not anticipate claims 2, 6, 8, 12, 14 and 18. M.P.E.P. § 2131.

Further, Debry does not disclose "wherein a copy of said certificate is stored in an enterprise database" as recited in claim 3 and similarly in claims 9 and 15. The Examiner recites column 6, lines 24-26 and 61-64 of Debry as disclosing the above-cited claim limitation. Paper No. 6, page 8. However, this language discloses a

database of the certificate authority that stores a new public key that was sent from the certificate authority to the printer. This language does not disclose storing a copy of a device certificate in an enterprise database. Thus, Debry does not disclose all of the limitations of claims 3, 9 and 15, and thus Debry does not anticipate claims 3, 9 and 15. M.P.E.P. § 2131.

As a result of the foregoing, Applicants respectfully assert that not teach and every claim limitation was found within the cited prior art reference and thus claims 1-3, 5-9, 11-15 and 17-22 are not anticipated by Debry.

VI. REJECTIONS UNDER 35 U.S.C. §103(a):

The Examiner has rejected claims 4, 10 and 16 under 35 U.S.C. §103(a) as being unpatentable over Debry in view of Netscape Communications Corp., "Netscape Certificate Server FAQ" 1997 (hereinafter "Netscape"). Paper No. 4, page 9. The reference Debry, which may qualify as prior art under 35 U.S.C. § 102(e), does not preclude patentability under 35 U.S.C. § 103 since Debry and the claimed invention in claims 4, 10 and 16 were at the time the invention was made, subject an obligation of assignment to the same person, which in this case was International Business Machines Corporation. 35 U.S.C. § 103(c). Thus, Debry is disqualified as being used as a prior art reference under 35 U.S.C. § 103(c). Consequently, the rejections of claims 4, 10 and 16 are moot.

VII. CONCLUSION

As a result of the foregoing, it is asserted by Applicants that claims 1-22 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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